

10/050,458Atty. Doc. No. G0208REMARKS

Claims 1-30 are currently pending in the subject application and are presently under consideration. Applicants' representative acknowledges with appreciation the indication of claims 29 and 30 as being allowed, and claims 12, 13, 16, 21, 22 and 24 as allowable, subject to being recast in independent form and reciting limitations of the base claim and any intervening claims. It is believed such amendments are not necessary at the present time in view of the deficiencies discussed *infra* regarding the cited references. However, applicants' representative reserves the option to recast such claims at a later date if necessary.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Objection To the Drawings

The drawings are objected to under 37 CFR §1.83(a). Applicants' representative has amended Fig. 1 by adding the legend "prior art" to resolve this objection. A proposed drawing correction to Fig. 1 is enclosed. A new set of formal drawings incorporating such changes will be filed as a separate document. Withdrawal of this objection is respectfully requested.

II. Rejection of Claims 25-28 Under 35 U.S.C. §102(b)

Claims 25-28 stand rejected under 35 U.S.C. §102(b) as being anticipated by Rose *et al.* (US Patent 4,675,530). Withdrawal of this rejection is respectfully requested for at least the following reasons. Rose *et al.* does not teach or suggest the claimed invention.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987)).

The subject invention as claimed relates to controlling electro-static discharge accumulated on a semiconductor piece during its processing, by dispersing an anti-static solution thereupon. Independent claim 25 recites; *bringing* the target device *in contact*

10/050,458

Atty. Doc. No. G0208

with an *anti-static substance*. Such aspects of applicants' claimed invention are not taught or suggested by Rose *et al.* Rather, Rose *et al.* teaches an apparatus for measuring charge distribution of a work piece – not *controlling* an electro-static discharge by *bringing* the target device *in contact* with an *anti-static substance*, as in applicants' claimed invention.

In view of the at least above comments it is readily apparent that Rose *et al.* does not teach or suggest the subject invention as recited in independent claim 25, and claims 26-28 dependent therefrom, and this rejection should be withdrawn.

III. Rejection of Claims 1-11, 14, 15, 17-20, 23 Under 35 U.S.C. §103(a)

Claims 1-11, 14, 15, 17-20, 23 stand rejected under 35 U.S.C. §103(a) as being obvious over Lewis *et al.* (US Patent 5,308,447) in view of Chao *et al.* (US Patent 6,162,565) and in view of Rose *et al.* Withdrawal of this rejection is respectfully requested for at least the following reasons. Lewis *et al.*, alone or in combination with Chao *et al.* or Rose *et al.* neither teach nor suggest applicants' claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, *the prior art reference (or references when combined) must teach or suggest all the claim limitations*. See MPEP §706.02(j). *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The claimed invention is directed to a method and system that controls static charges during fabrication of a semiconductor target device, *via* an antistatic solution that is brought into contact with the target device. Independent claim 1 recites; to dispense an *anti-static solution* on the target device [...] *controls a static charge* of the target device

10/050,458

Atty. Doc. No. G0208

via discharge adjustment of the *anti-static solution*. Similar limitations are recited in independent claims 9, 15, and 20. Such aspects of applicants' claimed invention is not taught or suggested by Lewis *et al.*, alone or in combination with Chao *et al.* or Rose *et al.* Lewis *et al* discloses techniques for *removal* (or forming layers) of *material* – not *control of a static charge* as is in applicants' claimed invention (the anti-static solution of applicants' claimed invention neutralizes static charge at the surface of the target device *without* substantially etching or contaminating the surface, See subject specification at page 9, lines 18-20).

Moreover, Chao *et al.*, alone or in combination with Rose *et al.* fail to make up for the aforementioned deficiencies of Lewis *et al.*, in fact the term "static" does not even appear in any of the cited references. Chao *et al.* is directed to forming a photo-mask *via* an *etching* mechanism, and as explained *supra* Rose *et al.* teaches an apparatus for measuring the charge distribution of a work piece – not *control of a static charge* as in applicant's claimed invention.

In view of the at least above comments, it is readily apparent that Lewis *et al.*, alone or in combination with Chao *et al.* or Rose *et al.*, do not teach or suggest the claimed invention as recited in; independent claim 1, independent claim 15, independent claim 21 and claims 2-8, 10-14, claims 16-19, claims 22-24 respectively dependent therefrom, independent claim 9 and independent claim 20. Withdrawal of this rejection is respectfully requested.

10/050,458

Atty. Doc. No. G0208

Conclusion

The present application is believed to be condition for allowance in view of the above amendments and comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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